



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

D. Rich Lang

Filed: January 31, 2001

Serial No: 09/773,343

For: AVIATION CHECKLIST AND
METHOD OF ADVERTISING WHICH
INCORPORATES AN AVIATION
CHECKLIST

Atty. Ref. No.: 44PA0300

Examiner: Willmon Fridie, Jr.
Group Art Unit: 3722

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TECHNOLOGY CENTER R3700

Assistant Commissioner for Patents
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Group Art Unit 3722
Washington, D.C. 20231

Dear Sir or Madam:

EXPRESS MAIL CERTIFICATE

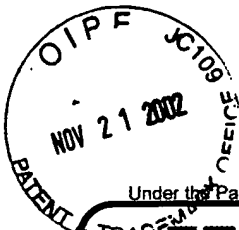
"Express Mail" Label Number EU756864837 US

Date: Nov. 21, 2002

I hereby certify that the enclosed "Applicant's Response to Second Office Action, including marked-up and clean versions of Amended Claims, are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR §1.10 on the date indicated above and is addressed to the Assistant Commissioner for Patents, Box RESPONSES, Group Art Unit 3722, Washington, D.C. 20231.

Robert R. Waters
(Typed or printed name of person mailing paper or fee)

(Signature of person mailing paper or fee)



PTO/SB/17 (10-02)

Approved for use through 10/31/2002 OMB 0651-0032

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FEE TRANSMITTAL for FY 2003

Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27TOTAL AMOUNT OF PAYMENT (\$)**460.00****Complete if Known**

Application Number	09/773,343
Filing Date	January 31, 2001
First Named Inventor	Lang
Examiner Name	Fridie
Art Unit	3722
Attorney Docket No.	44PA0300

METHOD OF PAYMENT (check all that apply)☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☐ Deposit Account:Deposit
Account
Number
Deposit
Account
Name

The Commissioner is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Credit any overpayments☐ Charge any additional fee(s) during the pendency of this application☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 740	2001 370	Utility filing fee	
1002 330	2002 165	Design filing fee	
1003 510	2003 255	Plant filing fee	
1004 740	2004 370	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	

SUBTOTAL (1) (\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

	Extra Claims	Fee from below	Fee Paid
Total Claims	-20** =	X	
Independent Claims	-3** =	X	
Multiple Dependent			

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 84	2201 42	Independent claims in excess of 3
1203 280	2203 140	Multiple dependent claim, if not paid
1204 84	2204 42	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description
1051 130	2051 65	Surcharge - late filing fee or oath
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet
1053 130	1053 130	Non-English specification
1812 2,520	1812 2,520	For filing a request for ex parte reexamination
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action
1251 110	2251 55	Extension for reply within first month
1252 400	2252 200	Extension for reply within second month
1253 920	2253 460	Extension for reply within third month
1254 1,440	2254 720	Extension for reply within fourth month
1255 1,960	2255 980	Extension for reply within fifth month
1401 320	2401 160	Notice of Appeal
1402 320	2402 160	Filing a brief in support of an appeal
1403 280	2403 140	Request for oral hearing
1451 1,510	1451 1,510	Petition to institute a public use proceeding
1452 110	2452 55	Petition to revive - unavoidable
1453 1,280	2453 640	Petition to revive - unintentional
1501 1,280	2501 640	Utility issue fee (or reissue)
1502 460	2502 230	Design issue fee
1503 620	2503 310	Plant issue fee
1460 130	1460 130	Petitions to the Commissioner
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)
1806 180	1806 180	Submission of Information Disclosure Stmt
8021 40	8021 40	Recording each patent assignment per property (times number of properties)
1809 740	2809 370	Filing a submission after final rejection (37 CFR 1.129(a))
1810 740	2810 370	For each additional invention to be examined (37 CFR 1.129(b))
1801 740	2801 370	Request for Continued Examination (RCE)
1802 900	1802 900	Request for expedited examination of a design application

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)**460****SUBMITTED BY**Name (Print/Type) **Robert R. Waters**
Signature **Robert R. Waters**Registration No. (Attorney/Agent) **43,241**

(Complete if applicable)

Telephone **304-522-6658**Date **Nov. 21, 2002****WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

R. Kent
12/2/02
#8/B

In re. Patent Application of:

D. Rich Lang

Filed: January 31, 2001

Serial No: 09/773,343 ✓

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Dear Sir or Madam:

APPLICANT'S RESPONSE TO
SECOND OFFICE ACTION

In response to the Office Action dated May 21, 2002, the Applicant hereby provides the following Response:

1) The Examiner has rejected Claims 1 - 16 under 35 U.S.C § 103 as being unpatentable over Esslinger, Jr. The Examiner further concluded that the claimed indicia is not functionally related to the substrate such as to provide distinction from the prior art to support patentability, as required by *In re Gulack* 217 USPQ 401 (CAFC 1983).

In response, the Applicant has amended Claim 1 to include the requirement of a tabbed index located on the edge opposite the binding means for the printed notebook. The tabbed edge is achieved by sizing the pages of the printed notebook such that each respective page or group of

pages is slightly longer than the previous page or group. For illustration purposes, we note that each tabbed page could be, for example, one-fourth inch longer than the preceding page. The location of the tabbed edges will facilitate ease of operation for the checklist in that it will be easier to locate types of information quickly from looking at the tabbed index.

The Applicant notes that the tabbed index is not disclosed, claimed or inferred by Esslinger, Jr. In fact, a tabbed edge would have no value in the type of instrument claimed by Esslinger, Jr. as it is certainly not necessary or useful to set forth a means for quickly moving from page to page or section to section in a calendar.

Given the new requirement set forth in Element d of Claim 1, Claim 1 is patentably distinguishable over Esslinger, Jr. such as to support patentability. In addition, for the same reasons, dependent Claims 2-9 are likewise patentably distinct over Esslinger, Jr. The Applicant respectfully requests approval of Claims 1-8 as modified.

Concerning method claims 9-16, the Applicant respectfully traverses the Examiner's rejection by noting that Claims 9-16 are method claims directed to a method for delivery of an advertising message. Accordingly, since the article of manufacture (Aviation Checklist) is not being claimed, but rather a method for conducting advertising, the printed indicia rejection is not applicable. As the Court set forth in *Gulack*, the PTO does not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. However, *Gulack* as well as more recent cases also applying the printed matter rejection apply only in situations in which the substrate itself is part of the claimed subject matter.

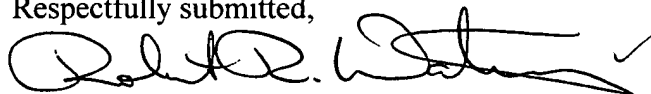
A printed matter rejection has no applicability to a business method claim such as Claims 9-16 for a method of delivering an advertising message. Furthermore, the Federal Circuit has

been hesitant to extend the printed matter rejection doctrine beyond the specific constructions of *Gulack* and others wherein an article of manufacture with printed indicia is claimed. The Court has noted in *Gulack* and other cases that "a printed matter rejection under §103 stands on questionable legal and logical footing." *In re. Edward S. Lowry*, 32 F.3D 1579 (Fed. Cir. 1994).

In view of the printed indicia rejection, Claims 9-16 were rejected by the Examiner as being unpatentable over Esslinger, Jr. Given that the printed matter rejection is inapplicable, Claims 9-16 of the present application are patentable over Esslinger, Jr. as the reference is directed to a calendar construction article with recipes and other printed information thereupon. Esslinger, Jr. is not directed to a business method for conducting advertising on an aviation checklist. Neither Esslinger, Jr. nor any other reference is directed to a method for advertising to operators of aircrafts wherein said advertising is conducted through the business method of providing advertising space on a required aviation checklist. Accordingly, the Applicant respectfully requests withdrawal of the rejection of Claims 9-16.

Having responded appropriately and in full to the Office Action, the Applicant respectfully requests allowance of the claims and advancement of the application to the Issue Branch. In keeping with patent office requirements, a clean version and marked up version of the modified claims are enclosed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert R. Waters", followed by a checkmark.

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Counsel for Applicant
D. Rich Lang

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